

REMARKS

Claims 1, 5, 8-10, 12-15, 18-19, 21, 24-40 are pending in this application. By this Amendment, claims 1, 15 and 21 are amended. No new matter is added. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

I. Amendments After Final Should be Entered

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments amplify issues previously discussed throughout prosecution); and (c) place the application in better form for appeal, should an appeal be necessary.

The current Amendment merely formalizes a meaning which is consistent with discussions held during interviews on January 4, 2005, May 18, 2005, and October 20, 2005, as well as in Amendments filed January 5, 2005, July 13, 2005, and November 7, 2005. Two RCE's have already been filed in the present application, and given the history of the present application, a third RCE should not be required in order for the current amendments to be entered. The amendments are necessary and were not earlier presented because they are made in response to a new interpretation of a claim term raised in the final rejection. Accordingly, entry of the amendments is thus respectfully requested.

II. §102(e) Rejection

Claims 1, 5, 8-10, 13-15, 18, 19, 21, 24 and 38-40 stand rejected under 35 U.S.C. §102(e) over U.S. Patent 6,738,841 to Wolff ("Wolff"). This rejection is respectfully traversed.

Independent claim 1 recites, *inter alia*, "inserting injectable control content into the received document at a specified location adjacent to the link to the retrievable item. . . wherein selection of the injectable control content initiates a functional operation upon the retrievable item identified by the link." (Emphasis added.) Wolff does not disclose, teach or suggest such a feature.

The Office Action asserts that the "create book" capability described in Wolff at col. 7, line 23 through column 8, line 5, teaches the above feature. Applicant disagrees.

As described in Wolf at col. 7, line 65 through col. 8, line 1, "After selection at book selection page 600, the selection data is transmitted to printer driver 255. Printer driver 255 waits for further instructions from client 210 on how to use the selected links."

Accordingly, checking a box adjacent to a document title on page 600 (e.g., see Wolff Fig. 6) results only in "selection data [being] transmitted to printer driver." In response to checking a box adjacent to a document title on page 600, no operation is performed on the "retrievable item identified by the link," as recited in the claims. This is because, "printer driver 255 [is waiting] for further instructions from client 210 on how to use the selected links."

For example, as stated in Wolf at col. 8, lines 1-19, no further action other than transmitting selection data to a printer driver is performed until additional buttons are selected (e.g., the Preview button, or the Print button on page 400). Because these button are on

screens different from the screen on which the check boxes are presented, the system described in Wolff requires a user to change the displayed screen before the button that initiates a functional operation upon a "retrievable item identified by the link" can be selected.

Accordingly, it is respectfully submitted that claim 1 is patentably distinguishable over Wolff. Claims 15 and 21 include features similar to those described above with respect to claim 1, and are likewise patentably distinguishable over Wolff for at least the reasons stated above. The remaining claims depend from one of claims 1, 15 and 21 and are likewise patentably distinguishable over Wolff for at least their dependence on an allowable base claim, as well as for additional features they recite. Accordingly, withdrawal of this rejection is respectfully requested.

III. §103 Rejections

The Office Action rejects claim 12 under 35 U.S.C. §103(a) as unpatentable over Wolff in view of U.S. Patent 6,301,586 to Yang et al. ("Yang"). Further, the Office Action rejects claim 25 under 35 U.S.C. §103(a) as unpatentable over Wolff. Still further, the Office Action rejects claims 26-29 and 31-37 under 35 U.S.C. §103(a) as unpatentable over Wolff in view of Yang. Yet further, the Office Action rejects claim 30 under 35 U.S.C. §103(a) as unpatentable over Wolff in view of U.S. Patent 6,618,163 to Roosen et al. ("Roosen"). These rejections are respectfully traversed.

As discussed above, independent claims 1, 15 and 21 recite, *inter alia*, "inserting injectable control content into the received document at a specified location adjacent to the link to the retrievable item. . . wherein selection of the injectable control content initiates a functional operation upon the retrievable item identified by the link." (Emphasis

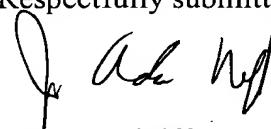
added.) As discussed above, Wolf does not teach or suggest such features. Yang and Roosen also do not disclose, teach or suggest such features. Therefore, any combination of Wolff, Yang and Roosen cannot make up for the identified deficiencies and would not have rendered obvious the invention recited in claims 1, 15 and 21. The remaining claims depend from one of independent claims 1, 15 and 21 and therefore include features similar to those described above. Therefore, these claims are allowable at least for their dependence on an allowable base claim. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 5, 8-10, 12-15, 18-19, 21, 24-40 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: March 24, 2006

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